REMARKS/ARGUMENTS

Applicant has reviewed and considered the drawings objections as "the drawings use terminology that is offensive" contrary to 37 CFR 1.3. Although it is true Applicant uses terminology which "could be deemed to any race...," the inclusion of such language is necessary so as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same. MPEP 608.01. In fact, it is such language that Applicant's invention is used to mask. Without such language, any person skilled in the art would not be able to make and use the invention as the offensive material would not be taught in the specification and the essence of the invention is not fully realized.

Next, Applicant has reviewed and considered the rejections of claims 1-5 based on non-statutory subject matter under 35 USC 101 and respectfully submits that his claims do fall under statutory subject matter for patentability as the element of offensive words using Applicant's invention promotes the useful arts by making literature available to children and other who might not otherwise be able to read it due to the offensive language.

Under States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998) and AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999), the invention must have practical utility, it must produce an assured result and it must not be merely an abstraction lacking in physical substance in order to determine whether the invention produces a useful, concrete, tangible result.

In Applicant's case, the claimed invention does produce a tangible result in the sense that it produces a physical transformation upon pre-existing material so as to change the character or condition of the pre-existing material. For instance, whereas the excerpt from The Adventures of Huckleberry Finn by Mark Twain displayed in Applicant's Figure 1 is objectionable to the examiner, many schools and libraries and the public at large, Applicant's Figure 2 wherein Applicant's invention is used on the excerpt, is not objectionable. Thus, the character and condition of the pre-existing material has changed from offensive to permissive by utilizing Applicant's invention. The tangible result is an offensive-free excerpt

from an American literary classic.

Moreover, the tangible result falls within the useful arts. Although no technology is disclaimed, the useful art wherein the tangible result is applied is within the public as a whole. Many persons are prevented from reading literary works as many of these classics contain offensive material, be it racial, sexual, religious or otherwise and are therefore banned from many public school systems. Rather than simply removing the offensive material to make the work 'safe', the books are removed in their entireties from the schools, thereby preventing entire generations from reading classic literary novels. Thus, the tangible result of permitting individuals to read classic literary novels safely promotes the useful arts.

With respect to the rejection of claims 1-4 under 35 USC 102 based on Cragun *et al.*, Applicant has amended claim 1 so as to be a box, rather than an ambiguous unoffensive symbol. Although it is true Cragun *et al.* teaches a censoring browser method and apparatus for Internet viewing wherein compared word and word fragments matching user selected censored words and word fragments can be removed and selectively replaced with *predefined characters* or acceptable *substitute words* (emphasis added), Cragun *et al.* does not teach the utilization of a box to replace words as does Applicant's invention. As claims 2-4 are dependent upon claim 1 and claim 1 is no longer anticipated by Cragun *et al.*, these remaining claims are also no longer anticipated by Cragun *et al.*.

With respect to the rejection of claims 1-5 under 35 USC 102 based on Kasha, Applicant has amended claim 1 so as to be a box, rather than an unoffensive symbol. In Kasha, although it is true if Figure 11 of Kasha that a box shape covers an area of text, these boxes are actually "adhesive flaps" (77) which are positioned over selected symbols (see column 10, lines 49-50). "Such flaps which hide a selected portion of the text, or a character, and which provide a surface for writing in the hidden portion, allow rapid lifting to quickly reveal the symbol or text if the student is unsure of the shape of the character or the proper word sequence or spelling" (see column 11, lines 4-9). Thus, these adhesive flaps do not actually replace the material to be banned as does Applicant's invention.

The essence of Applicant's invention is that it uses a box *in place of* said material to be banned (emphasis added). If Applicant were to use the Kasha adhesive flaps, individuals would still be able to view the material to be banned simply by lifting the flap. Applicant's invention totally eliminates the possibility of an individual from viewing the material to be banned. As claims 2-4 are dependent upon newly amended claim 1, these remaining claims are no longer anticipated by Kasha.

With respect to the rejection of claim 5 under 35 USC 103, as Applicant has now canceled claim 5, Applicant will treat this rejection as if it were a rejection of the newly amended claim 1 wherein a box is used in place of material to be banned.

Although the examiner takes official notice that the use of "black out boxes" sized to block out areas is well-known and Cragun *et al.* teaches a censoring browser method and apparatus for Internet viewing wherein compared word and word fragments matching user selected censored words and word fragments can be removed and selectively replaced with *predefined characters* or acceptable *substitute words* (emphasis added), it would not be obvious to utilize a "black box" to replace the entire area of material to be banned with the method of Cragun *et al.*.

Cragun *et al.* replaces user selected censored words with predetermined characters or substitute words. A "character" is defined as "a symbol (as a letter or number) that represents information" (see Merriam-Webster Online Dictionary). Thus, Cragun *et al.*'s predefined characters may be either symbols, *i.e.*, "*'s," as is described in column 5, lines 26-27, or alphanumeric characters, *i.e.*, "a", "b", "1," or "2." On the other hand, Applicant's box is more likened to a shape or drawing, rather than a "character." Additionally, a box does not fit the mold of a character as it 1) is not a stand-alone symbol but rather must be drawn and 2) is not found on a computer keyboard or typewriter.

Thus, as Cragun *et al.* teaches the replacement of selected words with predefined characters or acceptable substitute words and Applicant's box is not a character nor a word, it would not have been obvious to one skilled in the art to use a box in combination with the method taught in the Cragun *et al.* patent.

Finally, as a typographical error was noticed in claim 4, Applicant has amended claim 4 to correct this mistake.

In view of the above amendments and remarks, Applicant believes the examiner will now find this patent application in a position for allowance and its expeditious passage to same is requested.

Should the examiner disagree or have any questions, comments or suggestions that will render this application allowable, a call to the undersigned attorney of record is invited.

Respectfully submitted,
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CERTIFICATE OF MAILING UNDER 37 CFR 1.10

I HEREBY CERTIFY that the above Response and Amendment is being deposited with the United States Postal Service by "Express Mail Post Office to Addressee" service, U.S. Express Mail No. EV 589509365 US, on the 4th day of March, 2005, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Legal Assistant